

Appl. No.: 09/856,835
Group Art Unit: 1623

REMARKS

Claims 24-35 are currently pending in the present application.

New claims 24-35 have been added to replace canceled claims 12-23. New claims 24-35 find support in previously pending claims 12-23 and in the original claims, as well as the Specification, for example, at page 3, line 15 through page 4, line 19. New claim 24 is substantially similar to canceled claim 12. However, new claim 24 has been written to omit the allegedly objectionable phrase "like an ester"; and to specify that in a certain set of circumstances, a particular substituent, namely an R² substituent at the primary hydroxyl group of the sugar, may not comprise a hydrophobic aromatic carboxylic acid moiety. New claims 25-35 correspond almost identically to canceled claims 13-23. New claim 31 which corresponds to canceled claim 19 has been written to specify that R⁵ represents an alkyl group having from 1 to 4 carbon atoms. Support for this amendment can be found in the Specification at page 7, line 2. The amendments made herein introduce no new matter. The amendments made herein do not require the payment of any additional claims fees. All of the amendments to the claims made herein, constitute the addition of new claims and/or deletions of entire claims. Accordingly, pursuant to 37 C.F.R. §1.121(c)(1)(ii), inclusion of new claims 23-30 on the separate page captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE" is not necessary. Entry of the amendments made herein is therefore proper and respectfully requested.

In Paper No. 9, the Examiner rejects claims 12-23 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which Applicants regard as their invention. Specifically, the Examiner contends that the phrase "like an ester" in claim 12 rendered the claim confusing, vague and indefinite as it "implies other chemical groups." (See, Paper No. 9, p. 2) Additionally, the Examiner contends that "R⁵" in claim 19 lacks antecedent basis.

In Paper No. 9, the Examiner rejects claims 12-17 and 23 under 35 U.S.C. §102(b), as being anticipated by CAPLUS Abstract No. 125:323005, Keapigu, *et al.*, "Chemical Studies on Antituberculosis Compounds from *Salix Capitata*.", ZHONGGUO YAOKE DAXUE XUEBAO, Vol. 27(5), pp. 271-273 (1996) (hereinafter referred to as "Keapigu").

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While not necessarily agreeing with the Examiner's rejections, nor the arguments and contentions in support thereof, Applicants have canceled claims 12-23, without prejudice. Thus, the Examiner's rejection of those claims is rendered moot. However, in the event that the Examiner were to apply such arguments and contentions in support of a similar rejection of new claims 23-30, Applicants strenuously, but respectfully, traverse such potential rejections for the reasons set forth below in detail.

As discussed above, new claim 24 has been written to omit the phrase "like an ester". One of ordinary skill in the art, upon reading the instant claims and Specification, would recognize that where R^2 represents a $C(O)R^4$ acyl group, that the linkage between the sugar hydroxyl and the acyl group is an ester linkage. Thus, while the language is not unclear, it has been removed from the new claims. Additionally, R^5 which is positively recited in new claim 31 has been defined as representing an alkyl group having from 1 to 4 carbon atoms. Accordingly, there is no longer any lack of antecedent basis.

Accordingly, Applicants respectfully submit that the new claims are definite and fully comply with the requirements of §112, second paragraph.

New Claim 23 has been written to specify that where R^1 is hydrogen, Z is glucose and n equals 1 and the glucose unit is substituted by R^2 at its primary hydroxy group, as in the *Salix capitata* leaf-derived compound disclosed by Keapigu, that R^2 is not the hydrophobic aromatic carboxylic acid moiety, 3-hydroxyphenyl-acryloyl, which is specifically disclosed in Keapigu. The exclusion of the hydrophobic aromatic carboxylic acid moiety disclosed in Keapigu is supported by Applicants' Specification at page 4, lines 16-19.

Thus, the claimed salicyl alcohol derivatives are not anticipated by the *Salix capitata* leaf-derived compound disclosed in Keapigu. Applicants respectfully submit that the new claims are patentable in over Keapigu.

In view of the amendments made herein and the comments set forth above, Applicants submit that all pending claims fully comply with the requirements of 35 U.S.C. §112, second paragraph, and that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in combination. Accordingly, reconsideration,

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withdrawal of the rejections and a Notice of Allowance for all pending claims are respectfully requested.

Respectfully submitted,

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